STATEMENT OF SUBSTANCE OF THE INTERVIEW

As a preliminary matter, Applicant's representative would like to thank the Examiner and Examiner's Supervisor for courtesies extended in the telephone interviews conducted on October 21, 27, and 31, 2011 and November 1, 2011.

The Examiner agreed that claim 1 and its dependent claims are in condition for allowance. Further, the Examiner proposed an amendment to claim 24 for placing the application in condition for allowance.

Applicant agreed with the Examiner's proposed amendment to claim 24. The Examiner stated that he will allow the case.

REMARKS

Entry of this Amendment is proper because it narrows the issues on appeal and does not require further search and/or consideration by the Examiner.

Claims 1, 4-8, 13-15, 17-21, and 24-28 are all of the claims pending in the present Application. Applicant has amended claim 24 and cancelled claim 29 without prejudice or disclaimer. Non-elected claims 6-8, 19, and 20 are withdrawn. No new matter is added.

While the claim amendments made herein may help to distinguish the invention over the prior art, Applicant's intention in making the amendments is for the purpose of particularly pointing out the invention, and not for the purpose of distinguishing the invention over the prior art, narrowing the claims, or for any statutory requirements of patentability. Further, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 1, 4, 5, 13-15, 17, 18, 21, and 24-29 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Shiozaki (WO 03/044881) in view of Chen et al. (CN 1416189, hereinafter "Chen"). Claims 21 and 28 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Shiozaki and Chen, and further in view of Cho (U. S. Patent Pub. 2003/0211391).

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention (e.g., as defined by exemplary claim 1) is directed to a positive active material.

The positive active material includes base particles able to dope and release lithium ions, and an oxide of at least one element selected from the group consisting of Gd, Ce, and Yb on at least part of a part of the base particles which is able to come into contact with an electrolyte.

The at least one element is formed on a surface of the base particles, and is not incorporated in the base particles. A weight percent of the at least one element in terms of oxide is in a range from 0.01% to 4% of a total weight of the base particles and the at least one element

in terms of oxide.

In the claimed invention, by regulating the deposition amount to 4% by weight or smaller, the possibility of battery capacity decrease can be diminished (e.g., see application at page 27, lines 7-12).

II. THE ALLEGED PRIOR ART REFERENCES

A. Shiozaki and Chen

The Examiner alleges that Shiozaki would have been combined with Chen to form the invention of claims 1, 4, 5, 13-15, 17, 18, 21, and 24-28. However, Applicant respectfully submits that these alleged references would not have been combined and even if combined, the alleged combination would not teach the features of the claimed invention.

In particular, Applicant respectfully submits that these references are unrelated. Indeed, no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

In fact, Applicant submits that the references provide no motivation or suggestion to urge the combination as alleged by the Examiner. Indeed, these references clearly do not teach or suggest their combination. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, neither Shiozaki, nor Chen, nor any alleged combination thereof teaches or suggests "*wherein a weight percent of said at least one element in terms of oxide is in a range from 0.01% to 4% of a total weight of said base particles and said at least one element in terms of oxide,*" as recited in claim 1, and similarly recited in claim 24.

Indeed, in the telephone interviews of October 21, 27, and 31, 2011 and November 1, 2011, the Examiner agreed that the cited references fail to teach or suggest the above feature of claims 1 and 24, and stated that he will allow the case.

Furthermore, Applicant submits that the claimed invention defines a positive active material, in which a predetermined range is 0.01% to 4%, as recited in claims 1, 24, and 29. Having this predetermined range is important, since the claimed range achieves unexpected

results relative to prior art, as shown in Table 5 in the present Application.

More specifically, as shown in Table 5 and disclosed in the related text in the Application, by adjusting the deposition amount to 0.01% by weight or larger, the effect of improving the cycle characteristics of the battery can be sufficiently produced. By regulating the deposition amount to 4% by weight or smaller, the possibility of battery capacity decrease can be diminished (e.g., see application at page 27, lines 7-12).

Indeed, in the course of intensive investigations made by the inventors of the present application on processes for producing under various conditions a positive active material having a Group 3 element imparted thereto, they utterly surprisingly found that the decrease in discharge capacity can be inhibited when imparting a Group 3 element to base particles is conducted under specific conditions, as set forth in the claimed range (e.g., see application at page 15, lines 3-10).

The cited references, either alone or in combination (arguendo), do not even recognize the problems addressed by the present invention, let alone teach or suggest (and thus provides a much different structure than) a solution similar to that of the present invention. Therefore, the alleged references fail to teach or suggest this feature of the claimed invention.

Therefore, Applicant respectfully submits that these alleged references would not have been combined and even if combined, the combination would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

B. Cho

The Examiner alleges that Shiozaki and Chen would have been further combined with Cho to form the invention of claims 21 and 28. However, Applicant respectfully submits that these alleged references would not have been combined and even if combined, the alleged combination would not teach the features of the claimed invention.

In particular, Applicant respectfully submits that these references are unrelated. Indeed, no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

In fact, Applicant submits that the references provide no motivation or suggestion to urge

the combination as alleged by the Examiner. Indeed, these references clearly do not teach or suggest their combination. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, Applicant submits that similar to Shiozaki and Chen, Cho fails to teach or suggest "*wherein a weight percent of said at least one element in terms of oxide is in a range from 0.01% to 4% of a total weight of said base particles and said at least one element in terms of oxide,*" as recited in independent claim 1, and similarly recited in independent claim 24.

Clearly, this feature is not taught or suggested by Cho.

Indeed, Applicant notes that Cho teaches an active material for a battery, and a surface-treatment layer formed on the active material (Cho at Abstract). Cho, however, fails to teach or suggest the above feature of claims 1 and 24.

Thus, Cho clearly does not make up for the deficiencies in Shiozaki and Chen.

Therefore, Applicant respectfully submits that these alleged references would not have been combined and even if combined, the combination would not teach or suggest each and every feature of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1, 4, 5, 13-15, 17-18, and 24-28, all the claims presently under examination, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 11/4/11

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I hereby certify that I am filing this paper via facsimile, to Group Art Unit 1729, at (571) 273-8300, on the date shown below.

Respectfully Submitted,

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